

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Before the Board of Patent Appeals and Interferences

In re the Application of

Ola OLOFSSON et al.

Serial No.: 09/910,960

Filed: July 24, 2001

For: **GUIDING MEANS AT A JOINT**

APPELLANT'S REPLY BRIEF

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Appellants submit this Reply Brief in response to the Examiner's Answer mailed June 5, 2008.

RESPONSE TO REJECTION OF CLAIMS 3-7, 9-15, 18-23 AND 25 UNDER 35
U.S.C. §103(a) AS BEING UNPATENTABLE OVER NELSON (U.S. PATENT NO.
5,618,602) IN VIEW OF MARTENSSON (WO96/27721)

Although the body of the Examiner's Answer, at page 3, has a marked-up Figure of Nelson '602 the "marked-up figure" does not constitute prior art, insofar as the Examiner is now including subject matter not within the original Figure 4 of the Nelson '602 patent.

Appellant reminds the Board that prior art is specifically defined in 35 U.S.C. §102, and unless it qualifies as "prior art" as defined by statute, it cannot be used in a rejection under 35 U.S.C. §103(a). Accordingly, Appellants request that the Board ignore Figure 4 as "marked-up" by the Examiner on page 3 of the Office Action, as well as remarks referring to such marked-up Figure 4 as set forth in the Examiner's Answer. Appellant also reminds the Board that the KSR International Co. v. Teleflex Inc., 127 S.Ct. 1727, 1741 (2007) specifically states that

[A] patent composed of several elements is not proved obvious merely by demonstrating that each of its elements was, independently known in the prior art. Although, common sense directs one to look with care at a patent application that claims as innovation the combination of two known devices, according to their established functions, it can be important to identify a reason that would have prompted a person of ordinary skill in the relevant field to combine the element in a way the claimed new invention does.

Moreover, rejections based on 35 U.S.C. §103 must rest on a factual basis. In making such a rejection, the Examiner has the initial duty of supplying the requisite factual basis and may

not, because of doubts that the invention is patentable, resort to speculation, unfounded assumptions or hindsight reconstruction to supply deficiencies in the factual basis. *In re Warner*, 379 F.2d 1011, 1017 (CCPA 1967).

It is noted that in the invention (for example by reference to independent claim 7) that a guiding means at a joint between adjacent boards is claimed. The boards comprise an upper surface and a core and bounded by edges and at least one of the edges comprising a groove or tenon, the groove or tenon comprising a plurality of guiding wedges. Appellants further define the tenon as having an angled distal surface and that at least one of the guiding wedges is positioned between the angled distal surface and the core. Such is shown, for example, in Appellants Figure 4 of the drawings, in which the tenon 2 extends from the core so as to terminate in the distal surface and such distal surface is provided with an angled shape. Between such angled shape and the core are provided a plurality of guiding wedges 3 extending from the angled distal surface to the core.

In the Examiner's Answer, in response to Appellant's argument (page 14, lines 1-2) that Martensson does not show a section extending from said distal angled section to said core, the Examiner concedes that "it is not Martensson, but rather Nelson that is relied upon to disclose this limitation".

Accordingly, the Examiner has now conceded that if such limitation is not found in the Nelson '602 patent it cannot be found in the proposed combination of Nelson '602 with Martensson.

The only basis upon which the Examiner can even formulate an argument that Nelson '602 teaches such a limitation is the Examiner's "marked-up" Figure 4 appearing on page 3 of the Examiner's Answer. Although such marked-up Figure 4 is not "prior art" within the sense of 35 U.S.C. §102 (as noted above) and, hence, cannot be used in a rejection under 35 U.S.C. §103, the Examiner's entire rejection is based only on the marked-up drawing, which itself, is not prior art.

Turning to the actual Nelson '602 disclosure (including original Figure 4 as well as the totality of the description relevant thereto), there is absolutely no disclosure of the limitations of Applicants' claims found in the Nelson '602 patent.

Thus, the Examiner's entire 35 U.S.C. §103 rejection is premised on a marked-up Figure 4 of Nelson '602 in order to create additional disclosure not found in the original patent. Neither *KSR* nor *In re Warner, supra*, support the proposition that prior art figures can be redrawn so as to include additional subject matter not found in the original disclosure in order to meet claimed limitations in Applicants' claims during examination. Thus, all the rejections based on the proposed combination of Nelson '602 in view of Martensson must fail and be reversed.

**APPELLANTS PROVIDE THE FOLLOWING ADDITIONAL ARGUMENTS
WITH REGARDS TO THE PREVIOUS REJECTION OF CLAIMS 3-7, 9-15, 18-
23 AND 25 UNDER 35 U.S.C. §103(a) AS BEING UNPATENTABLE OVER
NELSON '602 IN VIEW OF MARTENSSON**

The invention, as defined by independent claim 7, also includes the limitation that "the plurality of guiding wedges are arranged perpendicular to the extension of the joint", as well as the additional step of "glue is applied during a manufacturing process of the boards".

As to the latter limitation, the Examiner suggests, (the Examiner's Answer page 4, middle of the page) that "glue (20) is applied during a manufacturing process to the boards (i.e., the manufacturing process shown in Figures 1;4) [of Nelson '602]". Nelson '602 does not show any manufacturing process of the boards. Rather, all that is shown in Figures 1-4 of Nelson is the assembly of previously manufactured boards. However, in Applicants' claimed invention, the glue is applied during the manufacturing process of the boards.

There is absolutely no disclosure in Nelson that Figures 1-4, or its related description of these figures, depict a manufacturing process for the boards. Rather, Nelson merely shows assembly of previously manufactured boards which are joined together with glue during the assembly of the boards into a floor. Because the burden is upon the Examiner of supplying the requisite factual basis he may not, because of doubts the invention is patentable, resort to speculation, unfounded assumptions or hindsight reconstruction to supply deficiencies in the factual basis, Warner, *supra*. The Examiner has pointed to no description in Nelson that suggests Figures 1-4 teach a manufacturing process of boards. While Nelson may teach an assembly of boards into a floor, such assembly of boards is not a manufacture of the boards, as instantly claimed.

As to the former limitation, i.e. "the plurality of guiding wedges are arranged perpendicular to the extension of the joint" the Examiner attempts to imply that he is unaware where the joint exists between the boards in either the claimed invention, or the Nelson '602 patent. He thus suggests that Martensson teaches guiding wedges (on both the top (9) and bottom

(9) of the tenon) which are arranged perpendicular to the extension of the joint (see Answer paragraph bridging pages 4-5).

Even if the Examiner's supposed ignorance as to where the joint is in Nelson, it is clear that neither top (9) or bottom (9) of Martensson, referred to by the Examiner, teach a plurality of wedges extending perpendicular to the joint. Thus, the proposed combination of Nelson '806 and Martensson still not teach all the limitations of the recited claims.

Furthermore, however, independent claim 7 requires the creation of a first fitting clearance (comprising a main part of a fit of the joint) and a second, guiding, fitting clearance (comprising a smaller part of the fit) which is not achieved or even addressed by the Examiner in the rejection. Although the Examiner has seen fit to create new disclosure in the form of a marked-up Figure 4, (found on page 3 of the Examiner's Answer) the "2FC" supposedly representing the second, guiding fitting clearance which is required by Applicants' claims to be smaller first fitting clearance (supposedly denoted by "1FC" in the Examiner's marked-up Figure 4, and explained in the first paragraph on page 4 of the Answer) is literally quite smaller than "2FC".

Thus, even though the Examiner has attempted to make new disclosure in the form of a marked-up Figure 4 on page 3 of the Answer, he still does not establish the limitations of Applicants' independent claim 7.

Furthermore, the limitations of claims 4-6, each dependent on claim 7, are nowhere mentioned by the Examiner in his proposed new Figure 4 on page 3 of the Answer.

Independent claim 19, like independent claim 7, requires not only that the guiding wedges are arranged perpendicular to the extension of the joint formed by the first and second boards but also that glue is applied during manufacture of the boards.

Similarly, independent claim 23 requires not only that the glue be applied during manufacturing of the boards, but also that a first fitting clearance between the tenon and the groove, bounded by the distal end of the tenon at a proximal part of the groove in combination with a second, guiding fitting clearance being bounded by at least one side of a guiding wedge with a first fitting clearance comprising a main part of the fit and the second guiding fitting clearance comprises a smaller part of the fit is recited. As in independent claim 7, the guiding wedges are arranged perpendicular to the extent of the joint. No limitations are found in the proposed combination of Nelson '602 with Martensson.

Accordingly, it can be seen that none of the limitations in each of Applicant's independent claims, as well as many of the limitations of Applicant's dependent claims, are not found anywhere in the disclosure of Nelson '602 in view of Martensson.

For all the foregoing reasons, Applicants respectfully submit that the Examiner has utterly failed to even attempt to establish a *prima facie* case of obviousness based on the teachings of the prior art but rather must resort to creating new disclosure, in the form of his own drawings as

appears on page 3 of the Examiner's Answer, which drawings are, of course, not part of the prior art, having been created subsequent to Applicants' effective filing date.

Even when creating this new disclosure, the Examiner's attempt at identifying a second fitting clearance, smaller than the main fitting clearance falls woefully short of the claimed invention. Accordingly, reversal of all the rejections by the Board is respectfully requested.

The Director is hereby authorized to charge any deficiency in the fees filed, asserted to be filed or which should have been filed herewith, or credit any overpayment, to our Deposit Account No. 14-1437, under Order No. 8688.005.USCP02.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'TP Pavelko', with a long horizontal flourish extending to the right.

Thomas P. Pavelko

TPP:tnj

Date: August 5, 2008